

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALVARO Z. GALLEGOS

Appeal No. 97-2313
Application 29/024,479 ¹

HEARD: May 5, 1998

Before COHEN, FLEMING and HANLON, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of the

¹ Application for patent filed June 14, 1994. According to appellant, this application is a continuation of application 08/169,225, filed December 20, 1993, now patent no. 5,435,079, issued July 25, 1995.

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following design claim. ²

The ornamental design for SIDE, UPPER AND
SOLE PERIPHERY OF A SPRING SHOE as shown
and described.

As per the amendment filed May 12, 1995 (Paper No. 6),
appellant describes Figures 1 through 3 and Figures 4 through
6 as portraying first and second embodiments, respectively,
for the SIDE, UPPER AND SOLE PERIPHERY OF A SPRING SHOE. ³

As evidence of obviousness, the examiner has applied the
documents listed below:

Loederer et al	20,967	Dec. 05,
1896		
(Loederer)		
Miller	2,383,877	Aug. 28, 1945
Sink	4,241,524	Dec. 30,
1980		
Weber	4,566,206	Jan. 28, 1986
Gelli ⁴	310,571	Apr. 05, 1989

² As originally filed, the claim was for "The ornamental design for Shoe With Spring as shown and described".

³ The drawing figures were originally described by appellant in the specification as showing views of first and second embodiments of a "Shoe With Spring".

⁴ This document was first cited in the answer and applied in a new ground of rejection. A copy of a translation of this document is appended

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(European document)

The following rejections are before us for review.

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Weber in view of Miller, Loederer, and Sink.

The design claim further stands rejected under 35 U.S.C. § 103 as being unpatentable over Weber in view of Gelli and Sink.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 17), while the complete statement of appellant's argument can be found in the revised main, reply, and supplemental briefs (Paper Nos. 25, 18, and 20).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification, drawing, and design claim, the

hereto.

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applied prior art designs, the respective declarations of Ian Whately and Stanley Hockerson, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We are constrained to procedurally reverse each of the examiner's rejections under 35 U.S.C. § 103 since, as more fully explained, *infra*, the design claim is determined to be indefinite, to the extent that we are unable to ascertain the metes and bounds of the claimed design. In cases such as the present one, where claimed subject matter is indefinite, an evaluation thereof relative to prior art is inappropriate. See In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) and In re Steele, 305 F.2d 859, 134 USPQ 292, 295 (CCPA 1962)

As set forth above, the claimed ornamental design before us on appeal is for the "SIDE, UPPER AND SOLE PERIPHERY OF A SPRING SHOE, as shown and described".

The original specification in this design application described Figures 1 through 3 as views of a first embodiment

for the "Shoe With Spring", while Figures 4 through 6 were described as views of a second embodiment of the "Shoe With Spring". Figures 2 and 5 were specified as side views, with the opposite side being a mirror image.

As earlier indicated, Figures 1 through 3 are now described (Paper No. 6) as being views of a first embodiment for the "SIDE, UPPER AND SOLE PERIPHERY OF A SPRING SHOE", while Figures 4 through 6 are now described as being views of a second embodiment for the "SIDE, UPPER AND SOLE PERIPHERY OF A SPRING SHOE". ⁵

As is evident from the above drawing descriptions, the same figures of drawing that originally were disclosed as views of a design for a "SHOE WITH SPRING", now are described and claimed as portraying the design for "SIDE, UPPER AND SOLE PERIPHERY OF A SPRING SHOE", i.e., the now claimed design is not for a SHOE WITH SPRING but for the SIDE, UPPER AND SOLE

⁵ The application file reveals that the amendments made by appellant were responsive to the examiner's rejection under 35 U.S.C. § 112, first and second paragraph (Paper No. 4) to the effect that the claimed design was not fully disclosed; i.e., as explained by the examiner, for full disclosure top, front, and bottom views would be required for each embodiment.

PERIPHERY OF A SPRING SHOE. Thus, it readily appears to us that a "PERIPHERY" design, a design different from the overall design for a SHOE WITH SPRING shown in the original drawings, is now being claimed. However, all parts of the drawing Figures are in solid lines indicating, according to design practice, that everything depicted is part of what is being claimed. Thus, we conclude that the now claimed design is not the design depicted in the drawing (design for a SHOE WITH SPRING). ⁶

It follows from our above analysis that, as to the design claim on appeal, appellant errs in arguing (revised brief, page 8) and indicating that the now claimed invention is directed to the overall appearance of a spring shoe with a coiled conical

spring visible between the sole and heel (page 7, Paper No. 6) and that the claimed invention is directed to an ornamental design for a spring shoe having a coiled spring between the

⁶ The later claiming of a different design, e.g., a design encompassing only a portion of an originally disclosed overall design, raises a description (new matter) issue, as explained in a new ground of rejection, *infra*.

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sole and the heel (page 1 of the revised brief; Paper No. 25).

Contrary to appellant's expressed point of view, the claimed ornamental design on appeal is directed to the periphery "OF A SPRING SHOE", more specifically, the SIDE, UPPER AND SOLE PERIPHERY OF A SPRING SHOE, as shown and described. We are uncertain, however, as to what portion of the originally disclosed and claimed "SHOE WITH SPRING" depicted in the drawings is the now claimed design for the "SIDE, UPPER AND SOLE PERIPHERY" of a spring shoe. A *periphery* is the external boundary or surface of a body, or the outward bounds of something as distinguished from its internal regions or center.⁷ The original disclosure of this design application does not inform us as to what constitutes the side, upper and sole *periphery* of the spring shoe. The design application is designated by appellant as a continuation of Application Serial No. 08/169,225 (now U.S. Patent No. 5,435,079; copy attached to revised brief). The patent

⁷ Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979.

does not instruct as to what constitutes the "SIDE, UPPER AND SOLE PERIPHERY OF A SPRING SHOE".⁸ In light of the above, we are unable to determine what would be the periphery of the side, upper and sole of spring shoe, the design for which

⁸ Appellant calls upon this board to address the appropriateness of the present application being labeled a "continuation" (main brief, pages 17, 18 and reply brief, pages 6 and 7). In this case, all of the effective dates of the applied references predate the filing date of appellant's parent utility application Serial No. 08/169225 (U.S. Patent No. 5,435,079 to Gallegos). Ordinarily, under these circumstances, we would not have any reason to address the appropriateness of labeling the present application a "continuation". However, because of the difficulty we have encountered in understanding the language of the design claim on appeal, as explained above, we have had to review the content of the earlier utility application. Having considered the disclosure of the earlier application, this panel of the board makes the determination that the label "continuation" is a misnomer relative to the present design application. Neither of the two embodiments of the design in the present application, as partially portrayed in respective Figures 1 through 3 and Figures 4 through 6, appear (are disclosed) in the earlier utility application; lack of descriptive support under 35 U.S.C. 112, first paragraph. Aesthetically unlike the present design, the design of the embodiment of Figures 1 and 2 of the Gallegos patent includes, inter alia, the design appearance of a serrated ground impacting surface 14, a very deep "V" spacing between the two portions 16, 18 of the sole, an upper spacer 22, and a stepped hollow portion 28,30. Ornamentally unlike the present design, the design of the embodiment of Figure 4 of the Gallegos patent includes, inter alia, the design appearance of a very deep "V" spacing between the two portions of the sole, an upper spacer, and a stepped hollow portion. Ornamentally unlike the present design, the design of the embodiment of Figure 4A of the Gallegos patent includes, inter alia, the design appearance of a serrated ground impacting surface, a spacer 22N, and a ring-shaped spacer 28N. Simply stated, the present design cannot be found in the earlier utility patent. Thus, it is clear to us that the present design is not disclosed in the manner provided by the first paragraph of section 112, an integral part of 35 U.S.C. § 120 (Benefit of earlier filing date in the United States) in that the earlier application (Serial No. 08/169,225) contains illustrations that fail to depict the ornamental design illustrated and claimed in this present and later filed design application. See Racing Strollers Inc. v. TRI Industries Inc., 878 F.2d 1418, 1420 11 USPQ2d 1300, 1301 (Fed. Cir. 1989).

patent protection is being sought. It would be inappropriate on our part to speculate as to what is intended to be covered by appellant's

design claim. Simply as an example of the indefiniteness issue surrounding appellant's design claim, we note that there is no drawing figure in this design application which is a top view. Thus, the periphery (external boundary) of the sole, for example, is indeterminate based upon the showing in Figures 1 through 3 and Figures 4 through 6. It must, of course, be kept in mind that the addition of views depicting appearances not originally disclosed, as well as the removal of design appearances originally disclosed, each raise a description issue (new matter). Since the design being claimed is indeterminate, what would constitute an appropriate *Rosen* reference under 35 U.S.C.

§ 103 would likewise be indeterminate. See In re Rosen, 673 F.2d 388, 213 USPQ 347 (CCPA 1982).⁹ It is for the above

⁹ Appellant submits (reply brief, page 4, footnote 2) that the Gelli document would not be a proper basic reference. Declarants Whatley and Hockerson (declarations in APPENDICES A and B of main brief) each addressed the Weber patent as a basic reference, indicating in effect that Weber does

reasons, that the respective rejections of appellant's indefinite design claim under 35 U.S.C. § 103 have been procedurally reversed.

NEW GROUNDS OF REJECTION

Under the authority of 37 CFR 1.196(b), this panel of the board introduces the following new grounds of rejection.

35 U.S.C. § 112, first paragraph

The design claim is rejected under 35 U.S.C. § 112, first paragraph, as lacking descriptive support in the original disclosure.

As originally filed, a "SHOE WITH SPRING" was described and shown. The present, amended claim, alters the design for which patent protection was originally sought to a "PERIPHERY" design. A design, for example, the originally disclosed design, is a whole unto itself and is assessed in its entirety. The "PERIPHERY" design now claimed was not the originally described and claimed design, but clearly only a

not show an overall triangular support appearance which looks like the triangular support appearance of the design application with a conical spring. However, we note that the Gelli clog design displays an overall triangular support appearance encompassing the aesthetic form of a helical spring.

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"PERIPHERY" portion of the original design.

The test for determining compliance with the written description requirement of 35 USC § 112, first paragraph, is whether the disclosure of an application as originally filed reasonably conveys to an artisan that the inventor had possession at that time of the later claimed subject matter. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The now claimed "PERIPHERY" design, a design different from the originally disclosed and claimed design, is appropriately determined to lack descriptive support in the original disclosure. In our opinion, the original design application disclosure reasonably conveyed to a designer a shoe with spring design, as a whole, not a "PERIPHERY" design portion thereof.

35 U.S.C. § 112, second paragraph

The design claim is also rejected under 35 U.S.C. § 112,

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second paragraph, as being indefinite.

We determine that the metes and bounds of the claimed design are indeterminate. As earlier articulated, *supra*, the depicted design, as originally filed, was expressly set forth as portraying a "SHOE WITH SPRING, i.e., the entirety of a shoe's appearance as depicted in the drawing. Accordingly, the now claimed "PERIPHERY" design of a spring shoe is ambiguous in meaning when considered with the depiction in the original drawing, as explained earlier in this opinion, the content of which discussion is incorporated herein. For the reason that we cannot fairly ascertain the design now being claimed, the design

claim on appeal is appropriately determined to be indefinite under 35 U.S.C. § 112, second paragraph.

In summary, this panel of the board has:

reversed the rejection of the design claim under 35 U.S.C.

§ 103 as being unpatentable over Weber in view of Miller,

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Loederer, and Sink; and

reversed the rejection of the design claim under 35 U.S.C. § 103 as being unpatentable over Weber in view of Gelli and Sink.

Additionally, we have introduced new grounds of rejection under 37 CFR 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997)), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new ground of

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rejection to avoid termination of proceedings (§ 1.197(c)) as
to the rejected claims:

(1) Submit an appropriate amendment of the
claims so rejected or a showing of facts relating to
the claims so rejected, or both, and have the matter
reconsidered by the examiner, in which event the
application will be remanded to the examiner. . . .

(2) Request that the application be reheard
under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)

REVERSED

37 CFR 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
ADRIENE LEPIANE HANLON)	
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